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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,097	08/22/2003	Hugh M. Herr	OSSUR.010C1	8407

20995 7590 12/21/2006  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	12/21/2006	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/21/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

Office Action Summary

Application No.

10/646,097

Applicant(s)

HERR ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/5/2006; 6/16/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-99 is/are pending in the application.
- 4a) Of the above claim(s) 46-58 and 73-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/16/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2006 has been entered.

### ***Response to Amendment***

2. Applicants' amendment of claims 59, 60, and 65 in the reply filed on June 16, 2006 is acknowledged.
3. Applicants' cancellation of claims 1-45 in the reply filed on June 16, 2006 is acknowledged.
4. Applicants' addition of claims 71-99 in the reply filed on June 16, 2006 is acknowledged.

### ***Election/Restrictions***

5. Applicants' election of **Method/System**: Species A (embodied in claims 59-72) in the reply filed on October 5, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

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6. Claims 46-58 and 73-99 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 5, 2006.

### *Double Patenting*

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 65-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13, 14, 18, 19, 20, and 27 of U.S. Patent No. 6,610,101 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 65-69 of the application and claims 13, 14, 18, 19, 20, and 27 of the patent lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 13, 14, 18, 19, 20, and 27 is in effect a "species" of the "generic" invention of claims 65-69. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 65-69 are anticipated by claims 13, 14, 18, 19, 20, and 27 of the patent, it is not patentably distinct from claims 13, 14, 18, 19, 20, and 27.

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This rejection was previously addressed in the Office Action of April 21, 2005.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 59-64 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Regarding claim 59, the limitation “to control resistance of a magnetorheological damper” (see line 6) is indefinite as to the scope of the invention. To what particular resistance is said limitation referring? Claims 60-64 and 71 depend on claim 59.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 59-72 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Biedermann (US 6,423,098, B1; cited in Applicants' IDS).

Referring to Figure 1, Biedermann discloses a prosthetic knee system, and the method of controlling it (see column 2, lines 43-65), comprising a rotary magneto-rheological damper/brake operating primarily in shear mode (see column 1, line 67 to column 2, line 14; column 3, lines 1-7), a knee angle sensor (see column 2, lines 15-17), a load sensor (see column 2, lines 24-32; strain gauges are well-known load sensors), and a control unit 10 comprising a CPU and a data memory (see column 2, lines 33-42). At least one knee movement characteristic is measured, identified as a "control state", which "control state" is used to calculate a damping value, which damping value is used to control the resistance of the rotary magneto-rheological damper/brake operating in shear mode (see entire document). Biedermann, as an option, disclose a rotary piston "provided with vanes having a defined resistance within the cylinder dependent on the viscosity of the magneto-rheological liquid" (see column 3, lines 1-7), which rotary piston provided with vanes will subject the magneto-rheological liquid to shearing strain/stress.

Regarding apparatus/device claim 65, the functional limitations "operating primarily in shear mode"; "configured to measure"; "configured to send", etc., carry no patentable weight in the absence of any distinguishing structure. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

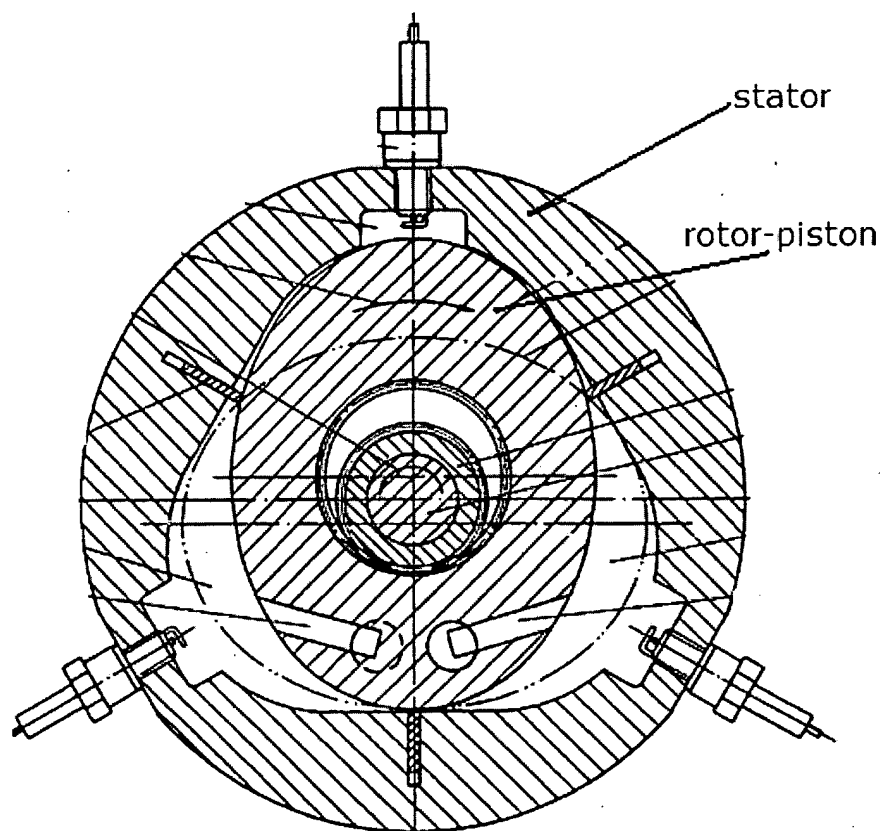
***Response to Arguments***

13. With regards to the 102(e) rejection based on Biedermann (US 6,423,098, B1; cited in Applicants' IDS), Applicants' arguments filed June 16, 2006 have been fully considered but they are not persuasive.

a. Applicants argue that Biedermann '098 does not disclose/suggest the magneto-rheologic damper as operating primarily in shear mode. The Examiner respectfully disagrees. Several online dictionaries (e.g., Merriam-Webster, Dictionary.com, Encarta, etc.) define the term "shear" or "sheared" (in the physics context) as: *"To become deformed by forces tending to produce a shearing strain"; "To subject to a shear force"; "To cause to move along the plane of contact"*. Biedermann, as an option, disclose a rotary piston "provided with vanes having a defined resistance within the cylinder dependent on the viscosity of the magneto-rheological liquid" (see column 3, lines 1-7), which rotary piston provided with vanes will subject the magneto-rheological liquid/fluid to shearing strain/stress. Rotary pistons are known for having/comprising a rotor and a stator (see an example in the Figure below). Since Biedermann '098 discloses a piston-cylinder device comprising a rotary piston, which piston may be provided with vanes, in contact with a magneto-rheological fluid (MR), it is then inherent that the magneto-rheological fluid will be constantly/primarily subjected to shearing forces between the rotor and the stator of the magneto-rheologic damper. The Examiner respectfully suggests the Applicants to indicate in the claim language that the MR fluid is sheared between a plurality of rotors and stators to generate a variable and controlled damping effect (language taken from the specification of the instant application). In other words, to differentiate (set apart) the claimed

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magneto-rheologic damper/brake/braking device (which comprises a plurality of rotors and stators) from other magneto-rheologic dampers/brakes/braking devices in the art.



### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Carlson et al. (US 5,277,281 A), and Carlson, J. David (US 5,711,746 A).

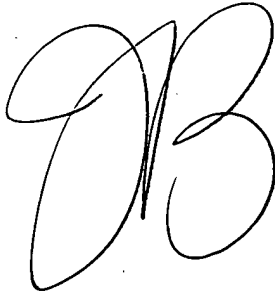
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

A large, stylized handwritten signature consisting of the letters 'J' and 'B' intertwined.

December 8<sup>th</sup>, 2006

A handwritten signature in cursive script that reads 'A. Stewart'.

**ALVIN J. STEWART  
PRIMARY EXAMINER**